

REMARKS

Claims 1-19 are pending in the Application. Of the claims remaining in the case, claims 1, 12, 13, 16, 17, 18 and 19 are independent claims. Claims 1-3, 5-10, and 12-19 stand rejected under 35 U.S.C. § 102(b) as being “anticipated by applicant admitted prior art Figure 5 and as disclosed in the specification on pages 12 and 13,” claims 1-10 and 12-19 stand rejected under 35 U.S.C. § 102(a) as being “anticipated by My Great Home®,” and claims 4 and 11 stand rejected under 35 U.S.C. § 103(a) as being “unpatentable over [either] Applicant admitted prior art [or My Great Home®] in view of USG.com (sheetrock brand joint compound).” For the reasons set forth below, Applicant respectfully traverses these rejections, and reexamination and reconsideration of the Application are respectfully requested.

35 U.S.C. §§ 102(a) and 102(b) Rejections

Claims 1-3, 5-10, and 12-19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Figure 5 and the content of pages 12 and 13 of Applicant’s specification, and claims 1-10 and 12-19 stand rejected under 35 U.S.C. § 102(a) as being “anticipated by My Great Home®.”

In order to make out a prima facie case of anticipation under 35 U.S.C. § 102, an Office Action must positively demonstrate that “each and every element as set forth in the [rejected] claim is found, either expressly or inherently described, in a single prior art reference.”

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987).

Because the Examiner has not met this burden in articulating the Section 102 rejections,

Applicant respectfully contends that the Examiner has failed to establish a prima facie case of

anticipation in the present Office Action. In any event, Applicant offers the following arguments in rebutting the Section 102 rejections.

As a threshold matter, it is Applicant's belief that the initial Section 102 rejections, as well as the Section 103 rejections discussed further below, are based on a fundamental misunderstanding of both Applicant's claimed invention and the admitted prior art, which misunderstanding has been confirmed, in Applicant's estimation, during the telephonic interview on November 3, 2006, and in view of the subsequent Interview Summary dated November 13, 2006. It is Applicant's hope that with the present written response the Examiner's misunderstandings will be corrected and a right foundation laid for further, more proper substantive review of the instant claims in light of any pertinent prior art the Examiner may later uncover based on her correct understanding of Applicant's invention.

Turning first to the claim rejections under Section 102(b) based on the Applicant-admitted prior art shown and described in Figure 5 and on pages 12 and 13 of the specification, as Applicant attempted to explain during the interview, what is shown and described as prior art by Applicant's own admission is utterly distinct from the claimed invention. As stated in the pages cited by the Examiner:

The conventional joint construction 110, as shown in Figure 5, includes abutting drywall boards 120, 130 having tapered first and second lengthwise edges 122, 132 so as to form a channel 140 that is partially filled in by a first taping coat 152. A drywall tape 160 is applied over the taping coat 152, and then the joint is

flushed by one or more topping coats 170 of joint cement over the tape 160. Thus, it is clear that in the typical prior art drywall joint, joint cement forms the center-line surface 180 directly over the channel 140. See page 12, line 26 – page 13, line 3.

In contrast to the above-described prior art joint construction, in the Applicant's joint construction, "a flexible layer 60, preferably of either tape or a flexible compound such as caulk, forms the center-line surface 80." See page 9, lines 18-20. Accordingly, as emphasized during the interview, this center-line surface, or the exposed surface of the drywall joint directly over the lengthwise crack 40 formed between abutting edges 22, 32 of adjacent drywall boards 20, 30, is stronger and less prone to cracking by eliminating the conventional weak and chalky joint cement in this surface area and replacing it with a flexible material such as tape or a compound such as caulk.

As further explained in the interview, historically, joint cement, as the name implies, was composed of a relatively higher percentage of resin or glue so as to be stronger than the drywall boards and tape in finishing a joint. But over time, and clearly by about the 1980's, the resin or glue content in such joint cements had been greatly reduced for ease of sanding and reduction of labor costs. The resulting joint cements still widely in use today are thus relatively weak and chalky and so are prone to surface cracking along the joint when there is any shift in the drywall boards or the underlying structure. Repair of such unsightly cracks is inconvenient and expensive.

Nevertheless, according to current, conventional thinking in the art, as evidenced, for example, by both the My Great Home® and Sheetrock® references cited by the Examiner, it is still believed or assumed that the typical joint cement is stronger than the drywall boards and tape, when, in fact, it is not, and so is continued to be used as the topping coat(s) to complete and flush the joint. Specifically, then, in the conventional drywall joint construction shown and described by Applicant in connection with prior art Figure 5 and as further disclosed in the My Great Home® reference, wherein it is expressly stated, whether for tapered or non-tapered joints (or boards), the joint is to be finished by “[p]ress[ing the] tape into [the] mud and cover[ing] with another thick layer of compound,” such relatively weak and chalky joint cements (or muds or joint compounds, as they are also referred to) clearly form the center-line surface of the joint. Again, this has serious disadvantages as explained by Applicant and overcome by his invention. Beyond these structural and aesthetic deficiencies of the prior art joint construction, it will be appreciated that the requirement for the application of numerous layers of such joint cement (three called out in both the cited My Great Home® and Sheetrock® references), each having to dry before the next is applied, and then concluding with a final sanding step (as also called out in the My Great Home® reference), all adds up to relatively significant material and labor costs.

Thus, in connection with both the Section 102(a) and Section 102(b) rejections, as distinct from the conventional drywall joint construction shown and described by Applicant in connection with prior art Figure 5 and as further disclosed in the My Great Home® and Sheetrock® references, Applicant’s joint construction in at least three variations essentially entails the absence of conventional joint cement at the center-line surface of the joint and instead the use of a flexible material or compound at such surface. In this way, it will be appreciated

that the drywall joint is finished much more quickly than in the conventional method with less materials and time, or labor costs, required. And the resulting joint, though relatively quicker and easier to finish, has also shown to be stronger and less prone to surface cracking (see page 13, line 7 – page 14, line 25).

With this understanding of the differences between the identified prior art and Applicant's invention, it is abundantly clear that the subject matter of independent claims 1, 12, 13, 16, 17, 18 and 19 is allowable over the art of record. As a threshold matter, as the Examiner noted in the Interview Summary, Applicant has already pointed out that the closed phrase "consisting essentially of," rather than the open phrase "comprising," has been employed in all such claims, whether for the joint construction itself or the method of its use, in order to make clear that the entire joint construction or methodology (i.e., all of its constituent parts or steps) is recited and anything not recited is not and cannot be part of the claimed invention. Thus, Applicant has made clear by the claim language that *none* of the claimed joint constructions or methods of use include joint cement at or forming the center-line surface of the joint. On this basis alone, the claims are all allowable as written since the prior art of record in *every* instance requires or teaches that joint cement would be positioned at or form the center-line surface of the drywall joint. In fact, the My Great Home® reference cited by the Examiner actually teaches away from Applicant's claimed invention by in every example of "Finishing the Drywall," again, whether with tapered or non-tapered boards, instructing the artisan to apply multiple coats of joint cement (compound or mud) *over* the drywall tape so as to thus form the center-line surface of such joint cement.

At this juncture it is also appropriate to correct a misstatement in the Interview Summary. The Examiner indicated that “Applicant’s representative further explained the edges of the drywall being straight or tapered as being a novel part of the invention” However, as will be clearly understood from the foregoing, the use of tapered and non-tapered drywall boards is known in the art and, hence, is in no way claimed to be a point of novelty of Applicant’s invention apart from the key distinction over the art of the absence of joint cement at the center-line surface of the joint, whether tapered, non-tapered, or of any other configuration now known or later developed.

In more detail, first, with regard to claim 1, it is recited that in the joint finishing system installed in the crack formed between adjacent drywall boards is “a flexible layer forming the center-line surface.” Once more, because this structure is not disclosed or suggested in the prior art of record, claim 1 is thus allowable as written. Accordingly, claims 2-11 that depend from claim 1 are also allowable.

Turning to independent claim 12, in closed language, it is recited more specifically that the drywall joint includes two drywall boards having tapered edges so as to form an outwardly-opening channel, taping compound filling the channel, tape covering the taping compound, and a skim coat applied over the marginal edges of the tape. As such, once again, the center-line surface of the joint is formed of a flexible material, here tape, rather than any sort of joint compound, much less the typical chalky joint cement as is known and used in the art. Accordingly, claim 12 is also in condition for immediate allowance. Claim 13 is analogous to claim 12, only with the use of non-tapered drywall boards so as to form a slit, rather than a

channel, therebetween that is then filled with taping compound and covered by tape so as to form the center-line surface of the joint. As such, claim 13 and claims 14 and 15 that depend therefrom are allowable as written over the prior art of record.

In independent claim 16, the drywall joint construction is recited as consisting in its entirety of non-tapered drywall boards with a flexible compound filling the slit formed therebetween. There is no tape or joint cement in the joint whatsoever, much less at the joint's center-line surface. Once more, such a drywall joint construction is neither disclosed nor suggested in the prior art of record, whereby claim 16 is also allowable as written.

Turning now to independent method claims 17-19, with each of these claims including the closed language "consisting essentially of the steps of," it is again clear any drywall joint finishing methodology that requires more than the recited steps cannot anticipate or make obvious the claimed invention.

In claim 17, then, the only three steps recited in forming the drywall joint are positioning a first drywall board on the support structure, positioning a second drywall board adjacent the first drywall board so as to form a lengthwise crack therebetween, and filling the crack with a flexible compound. If a methodology requires multiple coats of compound and/or the use of drywall tape, as in the prior art of record, such methodology clearly is not within the scope of claim 17, rendering this claim allowable on that basis. Again, not only does the prior art not teach that a drywall joint can be finished with a single coat of a flexible compound, rather than

multiple top coats over an embedded tape, it actually teaches away from the claimed method by only instructing the artisan as to the inferior multiple top coat approach.

For claims 18 and 19, further steps in the methodology are recited wherein a crack or channel formed between adjacent drywall boards is first filled with a taping compound, over which is then applied a drywall tape that is finally skim coated at its marginal edges. Here, though a compound and tape is employed, once again, the methodology expressly does not include or even allow for further topping coats to be applied over the tape as in the prior art, again rendering the claims allowable as having the tape at the center-line surface and no further coats thereon.

35 U.S.C. § 103(a) Rejections

Claims 4 and 11, each further limiting independent claim 1 by reciting that the taping compound or the flexible compound is a non-shrinking formulation, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either the Applicant admitted prior art or the My Great Home® reference in view of USG.com (Sheetrock® brand joint compound). First, as set forth above, because claim 1 alone has been shown to be allowable as neither anticipated by nor obvious in light of any of the prior art of record, alone or in combination, it follows that claims 4 and 11 are also allowable on this basis.

Furthermore, the “Sheetrock® Brand Setting-Type Joint Compounds” reference cited by the Examiner again actually teaches away from Applicant’s invention in several respects. In the section entitled “Gypsum Panel Joint Treatment,” USG clearly describes a method of use and

resulting joint structure again much like that disclosed by My Great Home®, wherein the joint is covered with “a thin layer of compound” to embed the drywall tape, once this has dried, “a second coat” is applied over the tape, and once this has dried, “a third coat” is applied over the second coat. Thus, while the Sheetrock® compound may be relatively non-shrinking in some sense, it is clearly by USG’s own teaching not capable of or designed to be applied in a single coat in finishing or flushing a joint, as is Applicant’s flexible compound, both by the literal claim language and as supported by the specification. Thus, while the cited Sheetrock® reference actually provides no details regarding the make-up of the “setting-type joint compounds,” it is implicit by the teaching of multiple coats that the kind of non-shrinking flexible compound disclosed and claimed by Applicant is not within the scope of this USG prior art disclosure.

Moreover, while other compounds may be shown to exist in the prior art that are more analogous to Applicant’s “flexible compound,” as in the form of caulks and the like, what is not taught in the art is to use such a flexible compound in finishing a drywall joint in a single coat and so form the center-line surface of the joint, as expressly recited in claim 11, which depends from claim 1 through claim 10. There is simply no prior art of record suggesting the combination of such a compound in a drywall joint construction. Rather, even the Sheetrock® reference makes no suggestion that such a compound could be applied in a single coat, with or without tape, to finish a joint. Thus, in sum, there is no prior art of record that suggests such a joint construction, much less a suggestion in the cited Sheetrock® reference to employ the disclosed “setting-type joint compound” as a single coat in finishing or flushing such a joint.

In claim 4, which depends from claim 1 through claims 3 and then 2, the flexible compound there recited actually relates to the taping compound beneath the drywall tape, with the drywall tape serving as the flexible material at the center-line surface of the joint rather than the flexible compound. In any case, such a flexible compound, in really any suitable formulation, and whether used over or under the drywall tape, is clearly not disclosed or even suggested in the art as a single coat joint finishing system. Accordingly, once more, claims 4 and 11 are further allowable over the prior art of record on these additional substantive bases.

Based on the foregoing, it is clear that Applicant has made a valuable contribution to the art of drywall joint finishing by providing a system and method effectively antithetical to decades of industry tradition and accepted practices and that actually overcomes deficiencies in those practices and yields a joint construction that is both improved and relatively less costly. It is respectfully submitted, then, subject to further searching that the Examiner may conduct, that claims 1-19 as presently pending all distinguish over the art of record and are in condition for immediate allowance. Prompt and favorable notice thereof is respectfully requested.

CONCLUSION

From the foregoing it is apparent that Applicant has made a valuable contribution to the art. All claims now in the case patentably distinguish over the prior art of record and are in condition for allowance. Consequently, early notice of allowance is respectfully solicited. If the Examiner is not in agreement, it is requested that she feel free to telephone the undersigned to discuss any concerns that may exist regarding allowance of the rejected claims.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Jeromye V. Sartain", with a long horizontal flourish extending to the right.

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